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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,594	05/03/2001	Sujal Bhalakia	589.063US2	8703

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EXAMINER

ZACHARIA, RAMSEY E

ART UNIT PAPER NUMBER

1773

DATE MAILED: 12/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/848,594

Applicant(s)

BHALAKIA ET AL.

Examiner

Ramsey Zacharia

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 50-58 and 80-83 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 50-58 and 80-83 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 13 July 2004 has been entered.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

3. Claims 50-57 and 80-83 are rejected under 35 U.S.C. 102(b) as being anticipated by Kawaki et al. (U.S. Patent 5,051,309).

Kawaki et al. teach a polarizing plate comprising a polarizing polymeric film (i.e. a functional layer) and polycarbonate plates (i.e. first and second resinous layers) bonded to both surfaces of the polymeric film (column 2, lines 22-29). The polymeric film may be made of polyvinyl alcohol (column 3, lines 24-29). The plates are bonded to the film using acrylic-type, epoxy-type, or urethane-type adhesives (column 3, lines 51-59). In the embodiment of Example 1, the polarizing plate has a thickness of about 1.5 mm (2 x 0.7 mm + thickness of PVOH film which is about 20-120 μ m (see column 3, lines 51-56)) was used as a lens and was molded to

have radius of curvature of 90 mm. Therefore, this plate will have a round shape (since it is a lens). Moreover, a laminate that is cut to fit snugly in a mold cavity is the same as a mold cavity that is designed to fit snugly over the laminate. Since the claims do not recite any dimensional limitations for the mold cavity, selecting a mold such that it fits snugly over the polarizing plate of Kawaki et al. would meet the limitation that the laminate has a dimension that snugly conforms to a mold cavity. Furthermore, since the claims are directed to only a laminate and not a laminate disposed in a mold cavity, the mold cavity recited in claim 50 is merely a hypothetical mold cavity that is not actually present in the claimed article.

The adhesives used by Kawaki et al. are taken to inherently have sufficient flexibility so as to substantially prevent crazing during injection molding, substantially prevent yellowing, and minimize shrinkage during cure since they appear to be the same adhesives used in the instant application (i.e. acrylic-type, epoxy-type, or urethane-type adhesives).

Regarding claims 55 and 56, the limitations of these claims are directed to the type of molded lens that the laminate is to be used to make. However, the claims are directed to a laminate and not a molded lens. As such, limitations drawn to the molded lens are directed to the intended use of the laminate and not structural limitations of the laminate itself. Since it has been held that a recitation with respect to the manner in which a claimed product is intended to be employed does not differentiate the claimed product from a prior art product satisfying the claimed structural limitations (see *Ex parte Masham*, 2 USPQ2d 1647 (1987)), the laminate of Kawaki et al. is taken to meet the limitations of claims 55 and 56.

Regarding claims 80-82, limitations further defining the mold cavity do not further structurally limit the laminate since the claims are directed to only a laminate and not a mold cavity or laminate disposed in a mold cavity.

Claim Rejections - 35 USC § 103

4. Claim 58 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kawaki et al. (U.S. Patent 5,051,309) in view of Guglielmetti et al. (U.S. Patent 5,631,720).

Kawaki et al. teach all the limitations of claim 58, as outlined above, except for the use of a photochromatic layer as the functional layer.

Guglielmetti et al. teach a photochromic compound that may be incorporated into a polymer for use in sunglasses (column 6, lines 8-13). Polyvinyl alcohol is a suitable polymer to which the photochromic compound may be added (column 6, lines 14-20). The photochromic compounds are used to screen out light radiation according to its intensity (column 1, lines 20-25 and column 2, lines 19-37).

One of ordinary skill in the art would be motivated to add the photochromic compound of Guglielmetti et al. to the polyvinyl alcohol layer of Kawaki et al. to yield sunglasses that are not only polarized but that also darken when exposed to intense light.

Response to Arguments

5. Applicant's arguments filed 16 June 2004 have been fully considered but they are not persuasive.

The applicants argue that a laminate having cut edges such that the laminate snugly conforms to a mold cavity corresponding to a front surface of an injection molded eye lens is very important structurally to the injection molded lens that is being made since the laminate must fit snugly within the mold in order to form an acceptable lens. The applicant argues that this limitation is missing from Kawaki et al. because forming a laminate film such that it fits within a frame for sunglasses or goggles is different from cutting a laminate to a precise dimension so that it can be properly used in a mold with a molten substance to form a molded eye lens.

This is not persuasive because the snug fit of a laminate in a mold cavity may be achieved not only by shaping the laminate to the mold but also by adapting the mold to the laminate. As such, a mold that is selected such that it fits snugly over the polarizing plate of Kawaki et al. would meet the limitation that the laminate has a dimension that snugly conforms to a mold cavity. The claims as written do not recite any dimensional limitations or restrictions for the mold cavity, therefore choosing a mold such that it fits snugly over the laminate would meet the limitation that the laminate has cut edges such that the laminate snugly conforms to a mold cavity. Furthermore, since the claims are directed to only a laminate and not a laminate disposed in a mold cavity, the mold cavity recited in the claims is merely a hypothetical mold cavity that is not present in the claimed article.

Regarding claim 58, the applicant argues that there is no apparent disclosure in either Kawaki et al. or Guglielmetti et al. to use a photochromatic layer in a laminate for an injection molded lens.

This is not persuasive because there is a direct teaching in Guglielmetti et al. of a photochromic compound that may be incorporated into a polyvinyl alcohol for use in sunglasses to screen out light radiation according to its intensity. As such, one skilled in the art would be motivated to add a photochromic compound of to the polyvinyl alcohol layer of Kawaki et al. to yield sunglasses that are not only polarized but that also darken when exposed to intense light. Whether the resulting laminate is for use as an injection molded lens is immaterial since the claims are directed to a laminate and not a molded lens.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramsey Zacharia whose telephone number is (571) 272-1518. The examiner can normally be reached on Monday through Friday from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones, can be reached on (571) 272-1535. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ramsey Zacharia
Primary Examiner
Tech Center 1700